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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,890	12/31/2001	Douglas A. Nagan	DUNHAM	4256
8933	7590	06/01/2006	EXAMINER	
DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196			HAVAN, THU THAO	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,890

Applicant(s)

NAGAN ET AL.

Examiner

Thu Thao Havan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/23/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

Response to Amendment

Claims 1-10 are pending. This action is in response to the amendment received March 16, 2006.

Response to Arguments

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-10** are rejected under 35 U.S.C. 102(e) as being anticipated by Peters et al. (US 2003/0088489).

Re claim **1**, Peters teaches a method for assessing risks (para. 0003 and 0006; Peters assesses a client's investment profile and evaluates the risk dimensions of the client's current portfolio holdings) comprising:

creating a questionnaire containing a series of questions for prompting a user to supply information segmented according to risk areas, wherein the risk areas encompass categories of potential loss (para. 0012; figs. 2a (element 2116), 4a-4b, and 12; Peters discloses risk assessment by having questionnaire in which the key questions seek to categorize the preferred risks);

providing a data store for recording data identifying user responses to the questions (figs. 2a, 3, and 4a-4b; Peters discloses a database for storing responses from user in relation to risk assessment);

programming a series of scoring rules containing an algorithm whereby the user responses are interpreted as indicating a predetermined level of risk at least as to categories of said potential losses (para. 0009-0013 and 0058, ; figs. 12 and 15; Peters discloses how expected return increases as risk increases in a programming algorithm);

presenting the questionnaire to a user and collecting the user responses in the data store (figs. 4a-4b and 14);

processing the user responses through the scoring rules and the algorithm to generate a report identifying risk levels according to the risk areas (para. 0007; figs. 15-17).

Re claim 2, Peters teaches storing a series of recommendations associated with the risk areas, selecting among the recommendations as a function of at least one of the user responses and the risk levels identified by said processing step, and presenting selected ones of the recommendations in the report (para. 0006-0007 and 0016). Peters recommends specific portfolio changes based on asset classes to create an optimized portfolio for the client's investment profile.

Re claim 3, Peters teaches creating a database and storing the questions and the user responses for a plurality of users for comparison in risk assessments of future users (para. 0062; figs. 2a, 3, and 4a-4b).

Re claim 4, Peters teaches at least one of segmenting of the risk areas, creating the questionnaire and composing the algorithm comprises reliance on available data and judgment of professionals skilled in the risk areas (para. 0081).

Re claim 8, Peters teaches questionnaire requires selection among a limited set of possible answers and the algorithm quantifies risk based on each possible answer (fig. 4a). In figure 4a, Peters illustrates the claimed limitations.

Re claim 9, Peters teaches questionnaire requires selection among yes/no and numeric answers (figs. 5 and 4a). In figure 5, Peters discloses yes/no answers and in figure 4a he discloses numeric answers.

Re claim 10, Peters teaches questionnaire permits at least one of a missing answer and an answer indicating a lack of information, and wherein the algorithm assesses the risk levels as a function of said one of a missing answer and said lack of information (figs. 4a-4b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **5-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al. (US 2003/0088489).

Peter does not explicitly teach risks are selected from the group consisting of risk of a claim of loss due to computational deficiency, denial of service, security breach, violation of legal regulations, tort, contractual breach, insufficient capacity to meet contractual requirements, breach of commitment of confidentiality, violation of intellectual property rights, failure to adhere to multi-jurisdictional differences in regulation. Nevertheless, Peters discloses risks assessment can be used in other embodiments (para.0096). Thus, it would have been obvious to one of ordinary skill in the art to include different risks as questionnaires scenarios for the same result as in the method that discloses in Peters.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH
5/25/2006



HANI M. KAZIMI
PRIMARY EXAMINER